

Application No. 09/918,262  
Response to Office Action of July 21, 2003

### REMARKS

The following remarks are responsive to the Final Office Action dated July 21, 2003. Claims 1-38 are pending. In the Office Action, the Examiner maintained rejection of claims 1-38 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,272,269 to Naum (hereafter Naum).

The Examiner's rejections are improper. Naum provides no disclosure or suggestion of the features recited in Applicant's claims. The Examiner has failed in establishing a prima facie case of anticipation, and has now issued final rejections that are clearly inadequate and contrary to well-established legal precedent. Moreover, the Examiner appears to be applying new rejections, i.e., rejections under 35 U.S.C. 103(a). For this reason, the finality of the current Office Action is also inappropriate.

On June 30, 2003, Applicant responded to the first Office Action with detailed explanations of a large number of differences between Naum and Applicant's claims. In particular, Applicant pointed out that Naum fails to disclose or suggest the features of Applicant's independent claims that recite light guides positioned at offset locations relative to the center axis of the light emitting diode. In addition, Applicant detailed numerous other features of Applicant's various independent and dependent claims that are not disclosed or suggested in Naum.

Now, the Examiner has issued a Final Office Action, which simply restates the legally inadequate rejections of the first Office Action. However, the Examiner appears to be attempting to further establish a case of non-obviousness under 35 U.S.C. 103(a), which would be a new rejection, making the finality of the Office Action inappropriate.

In the current Office Action, the Examiner indicated that one cannot show non obviousness by attacking references individually, where the rejections are based on combinations of references. The Examiner appears to be confused as to the legal standards for patentability and the differences between anticipation under 35 U.S.C. 102 and obviousness under 35 U.S.C. 103.

Application No. 09/918,262  
Response to Office Action of July 21, 2003

The current rejection is an anticipation rejection under 35 U.S.C. 102(e) and is only based on a single reference. Moreover, the law is replete with decisions that make it clear that, for an anticipation rejection under 35 U.S.C. 102(e), a single prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule." See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention"). If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(e) is improper. *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225; *Indus. Inc. v. Top-U.S.A. Corp.*, 63 USPQ2d 1597 (Fed. Cir. 2002).

All of Applicant's pending claims require light guides positioned at offset locations relative to the center axis of the light emitting diode. Moreover, all pending claims require that the light emitting diode emits a radiation pattern having a maximum luminous intensity that is displaced relative to a center axis of the light emitting diode. Naum simply fails to disclose positioning of light guides at offset locations relative to the center axis of the light emitting diode that emit a radiation pattern having a maximum luminous intensity that is displaced relative to a center axis of the light emitting diode. For this reason, the current rejections are improper and should be withdrawn.

In addressing Applicant's claimed feature reciting light guides positioned at offset locations relative to the center axis of the light emitting diode, the Examiner stated in the current Office Action:

...it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Naum to omit a central light emitting diode, especially in figure 10, since it has been held that omission of an element and its function in a combination where the remaining element perform the same function as before involves only routine skill in the art.

As a preliminary observation, Applicant notes that the Examiner's rationale is clearly an attempt to establish a new rejection, i.e., under 35 U.S.C. 103(a), making the finality of the Office Action inappropriate. Moreover, Applicant is puzzled as to the Examiner's rationale under 35 U.S.C.

Application No. 09 918,262

Response to Office Action of July 21, 2003

103(a). The Examiner appears to acknowledge that Naum does not disclose or suggest light guides positioned at offset locations relative to the center axis of the light emitting diode. However, the Examiner appears to be stating that by omitting the light emitting diode in Naum, light guides somehow become positioned at offset angles relative to the light emitting diode. Contrary to the Examiner assertion, however, the removal of the light emitting diode from the Naum system would not transform the Naum system to provide the features recited in Applicant's claims, such as light guides positioned at offset locations relative to the center axis of the light emitting diode.

Indeed, multiple light guides are not even illustrated in FIG. 10 of Naum, much less the specific positioning of multiple light guides at offset locations relative to a center axis of the light emitting diode, as required by Applicant's claims. Naum simply fails to disclose or suggest light guides positioned at offset locations relative to the center axis of the light emitting diode having a maximum luminous intensity that is displaced relative to a center axis of the light emitting diode, as recited in Applicant's independent claims. For these reasons, the current rejections are clearly improper, whether under 35 U.S.C. 102(e) or 35 U.S.C. 103(a).

In addition, Applicant's dependent claims recite numerous other features that are not disclosed or suggested in Naum, as detailed in the previous response, filed June 30, 2003. The Examiner has still failed to point to any teaching of Naum that discloses or suggests the numerous claimed features addressed in the previous response, filed June 30, 2003. In the current Office Action, the Examiner has seemingly ignored Applicant's arguments with respect to the dependent claims.

Applicant's claims include not one, but several elements that are not disclosed or suggested in Naum, as detailed in this response and the previous response, filed June 30, 2003. The anticipation rejections under 35 U.S.C. 102(e) are clearly improper and should be immediately withdrawn. To the extent the Examiner has changed the rejections to rejections under 35 U.S.C. 103(a), the finality of the current Office Action is improper. In any case, the Examiner has also failed to establish a prima facie case of obviousness under 35 U.S.C. 103(a).

The passages that the Examiner cited from Naum simply have little or nothing in common with the features of Applicant's claims. Applicant requests reconsideration, withdrawal of the finality of the current Office Action, withdrawal of the rejections, and allowance of all pending claims. A telephone interview between the primary Examiner and the below signed

Application No. 09,918,262

Response to Office Action of July 21, 2003

attorney has been scheduled for October 7, 2003 at 1:00 EST to further discuss this application.

In the meantime, the Examiner is invited to telephone the below-signed attorney to discuss this application prior to the interview of October 7, 2003.

Date:

09/19/2003

SHUMAKER & SIEFFERT, P.A.


8425 Seasons Parkway, Suite 105

St. Paul, Minnesota 55125

Telephone: 651.735.1100

Facsimile: 651.735.1102

By:



Name: Kelly Patrick Fitzgerald

Reg. No.: 46,326